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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,982	09/27/2001	Lori Jo Lehman	AQ 2018.20	7317

7590 06/04/2004
PHILIP D. REILLY
MORRISON & FOERSTER
755 PAGE MILL ROAD
PALO ALTO, CA 94304-1018

EXAMINER

WARE, DEBORAH K

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,982

Applicant(s)

LEHMAN ET AL.

Examiner

Deborah K. Ware

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/21/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-16 and 18-40 is/are pending in the application.
- 4a) Of the above claim(s) 32-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-16, 18-31 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-10, 12-16 and 18-40 are pending.

The amendments, extension of 3 months time, response, statement of deposit, terminal disclaimer filed January 28, 2004, have been received and entered of record. Further, the request to withdrawal as an agent or attorney filed March 3, 2004 is acknowledged, as is the change of power of attorney filed May 21, 2004.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

Claims 32-39 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention(s), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 13.

This application contains claims 32-39 drawn to an invention nonelected with traverse in Paper No. 13. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is rendered vague and indefinite for failing to recite clearly that the strain has been biologically purified and further because "the isolated" as recited in line 2, lacks antecedent basis.

Claim Rejections - 35 USC § 102/103

Claims 1-10, 12-16, 18-31 and 40 remain rejected under 35 U.S.C. 102(b) as being anticipated by Breinholt et al, previously cited on a PTO-892 Form, for those reasons of record, note pages 9-10 of the prior action.

Applicant's arguments filed January 28, 2004 have been fully considered but they are not persuasive. The argument that Breinholt et al do not anticipate the presently claimed invention is noted, however, the instant claims are not directed to a Streptomyces strain, but to a metabolite produced by a Streptomyces strain. The identical metabolite may be produced by other Streptomyces strains, and notably the Streptomyces strain of Breinholt et al., taught at col. 4, line 4. Applicants have not shown that their metabolite is any different from the metabolite disclosed by the cited reference. Therefore, the argument that a metabolite from the specifically claimed strain is not disclosed by Breinholt et al is not deemed persuasive.

Alternatively the argument that Breinholt et al do not render the instant claims obvious is also noted. However, all three requirements which must be satisfied in order to establish a prima facie case of obviousness have actually been met within the teachings of the cited reference. Applicants argue that their claims are limited to the strain, however, in fact they are directed to a metabolite produced by the strain; and this metabolite is considered to be the same but if there is some difference Applicants have

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not provided what the distinguishing characteristics are for which to provide for some difference from the cited prior art's metabolite.

There appears to be no difference between the claimed metabolite, composition containing it as well as methods for its use from what is disclosed by the cited prior art. The metabolite of the cited prior art is taught to be successful for treating Botrytis cinerea, note col. 9, line 27. Further, the metabolite of the cited prior art is applied to the root of the plant, note col. 9, line 39. Compositions containing the metabolite are disclosed, note col. 7, lines 4-16.

There is no reason for one of skill not to be motivated to select for the metabolite of the cited prior art for use in the claimed methods and compositions, especially since there appears to be no difference between the metabolite of the cited prior art and the claimed metabolite of which the crux of the claimed subject matter is directed to. The success of the metabolite of the cited prior is clear on the record and the claimed metabolite would have at least been expected to be successful and one of skill would have been motivated by the prior art teaching to provide for a metabolite from a Streptomyces strain because the reference does teach a metabolite which is obtainable from Streptomyces and other fungi. Thus, all three criteria have been satisfied to at least establish a prima facie case of obviousness. The rejection under 35 USC 102/103 is sustained.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


No claims are allowed.

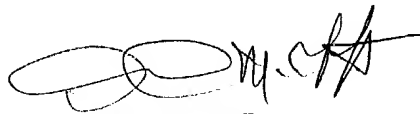
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 571-272-0924. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deborah K. Ware
May 29, 2004


DAVID M. NAFF
PRIMARY EXAMINER
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